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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/592,254 06/12/00 TURRI

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HM12/0720  
ARENT FOX KINTNER PLOTKIN & KAHN PLLC  
1050 CONNECTICUT AVENUE NW SUITE 600  
WASHINGTON DC 20036-5339

EXAMINER

MOON, M

ART UNIT

PAPER NUMBER

1623

DATE MAILED:

07/20/01

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

# Office Action Summary

Application No.

09/592,254

Applicant(s)

TURRI ET AL.

Examiner

M.P. Moon

Art Unit

1623

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) 1-16 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 17-20 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☒ Claims 1-20 are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are objected to by the Examiner.
- 11) ☐ The proposed drawing correction filed on \_\_\_\_ is: a) ☐ approved b) ☐ disapproved.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

## Attachment(s)

- 15) ☒ Notice of References Cited (PTO-892)
- 16) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 17) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 4.

- 18) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_.
- 19) ☐ Notice of Informal Patent Application (PTO-152)
- 20) ☐ Other:

## DETAILED ACTION

### *Election/Restrictions*

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
  - I. Claims 1-13, drawn to compounds of fluorinated oligourethanes and compositions thereof, classified in class 560, subclasses 25, 115, and 158.
  - II. Claims 14-16, drawn to a process of preparing fluorinated oligourethanes, classified in class 560, subclass 25, 115, and 158.
  - III. Claims 17-20, drawn to uses of oligourethanes and compositions, classified in class 560, subclasses 25, 115, and 158.
2. Inventions I and II are related as product made and process of making. The inventions are distinct if either or both of the following can be shown: (1) that the process as claimed can be used to make other and materially different product or (2) that the product as claimed can be made by another and materially different process (MPEP § 806.05(f)). In the instant case the process for preparing the oligourethanes could be performed in a melt rather than in solution.

Inventions I and III are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP § 806.05(h)). In the instant case the use as claimed can be practiced with a materially different product such as organopolysiloxane resins.

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Inventions II and III are related as process of making and process use. These inventions are distinct because the use as claimed can be practiced with a materially different product such as organopolysiloxane resins.

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art because of their recognized divergent subject matter, restriction for examination purposes as indicated is proper.

Because these inventions are distinct for the reasons given above and the class and STN or other online searches required for each of Group I, II, and III are unique and separate, restriction for examination purposes as indicated is proper.

4. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a petition under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

3. During a telephone conversation with Hans Crosby (Atty. Reg. # 44,634) on July 13, 2001 a provisional election was made with traverse to prosecute the invention of III, Claims 17-20, drawn to uses of oligourethanes and compositions. Affirmation of this election must be made by applicant in replying to this Office action. Claims 1-16 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

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***Claim Rejections - 35 USC § 112***

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. Claims 17-20 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 17-20 provide for the use of fluorinated oligourethanes, but, since the claim does not set forth any steps involved in the method/process, it is unclear what method/process applicant is intending to encompass. A claim is indefinite where it merely recites a use without any active, positive steps delimiting how this use is actually practiced.

6. Claim 17 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claim 17 recites the limitation "compositions according to Claim 1" in lines 1-2 of the claim. There is insufficient antecedent basis for this limitation in the claim. Claim 1 is not directed toward compositions.

***Claim Rejections - 35 USC § 101***

7. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

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Claims 17-20 are rejected under 35 U.S.C. 101 because the claimed recitation of a use, without setting forth any steps involved in the process, results in an improper definition of a process, i.e., results in a claim which is not a proper process claim under 35 U.S.C. 101. See for example *Ex parte Dunki*, 153 USPQ 678 (Bd.App. 1967) and *Clinical Products, Ltd. v. Brenner*, 255 F. Supp. 131, 149 USPQ 475 (D.D.C. 1966).

***Note: Method of Use***

8. Claims 17-20 are drawn to uses of oligourethanes and their compositions. The examiner has assumed these claims to be methods of use even though they are not written in proper format. The examiner is examining Claims 17-20 with respect to uses as oil-hydro repellent films and each of the claim limitations. No consideration of the method steps to effect such a use has been made.

***Claim Rejections - 35 USC § 102***

9. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

10. Claims 17-20 are rejected under 35 U.S.C. 102(b) as being anticipated by Dams et al (WO 92/17635) or Haniff et al (US 5,663,273).

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Dams et al exemplifies (Example 26, page 69) the oil- and water- repellency (before and after laundering and dry-cleaning) of polyester/cotton blend fabric after treatment with a polyurethane derived from acetone oxime, polymethylenepolyphenylisocyanate, N-methylperfluorooctanesulfonamidoethanol, isocyanatoethylmethacrylate, and 2-mercaptoethanol.

Haniff et al discloses (column 19, lines 1-34) the preparation of polyurethanes derived from 2,2,4-trimethyl-1,6-diisocyanatohexane and perfluorinated diols. Haniff et al further exemplifies (column 19, lines 62-67) a process of treating glass microscope slides with isopropyl acetate solutions of these polyurethanes and states that the coatings are both water- and oil-repellent. The preparation of a monofunctional hydroxyl perfluoropolyether possessing a crosslinkable function is disclosed (column 12, line 64 to column 13, line 27) for use as a component in the polyurethanes. Haniff et al expressly suggests (column 8, lines 17-50) a wide variety of aliphatic, cycloaliphatic and aromatic polyisocyanates as useful monomers. Haniff et al expressly suggests (column 8, lines 63-65) that polyurethanes of 3,000 to 30,000 molecular weight are preferred.

11. The prior art made of record and not relied on is considered pertinent to applicant's disclosure. Mueller (US 3,968,066) discloses the oil and water repellent properties of cotton-polyester treated with compositions of fluorochemical polyurethanes and ammonium salts. Deiner et al (US 4,834,764) discloses the oil and water repellent properties of cotton treated with low-molecular weight perfluoroalkyl-containing polyurethanes.

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12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to M.P. Moon whose telephone number is 703-306-5815. The examiner can normally be reached on weekdays between 9:00 am - 4:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gary Geist can be reached on 703-308-1701. The fax phone number for the organization where this application or proceeding is assigned is 703-308-4556 for regular communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0198.

*MPM*

M.P. Moon  
July 19, 2001



GARY GEIST  
SUPERVISORY PATENT EXAMINER  
TECH CENTER 1600